

REMARKS

Applicants acknowledge the Examiner's withdrawal of the prior rejections under 35 U.S.C. § 112 and § 102(b).

I. Disposition of the Claims

Claims 1-32 and 59 are pending in the present application. The Examiner has indicated that claim 59 is allowed and that claims 5, 6, 10-17, 23, 30 and 31 would be allowable if re-written in independent form, including all of the limitations of the base claim and the intervening claims. Applicants respectfully request the allowance of claim 59 be held in abeyance to allow for the Office to consider the enclosed remarks concerning claims 1-32, which Applicants submit have been demonstrated to be patentable over the cited prior art. Claim 27 has been amended herein to correct a clerical error and to more clearly define the claimed subject matter.

II. Rejection Under 35 U.S.C. § 103(a)

Claims 1-4, 7-9, 18-22, 24-29, and 32 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Arraudeau (U.S. Pat. No. 5,154,916 ("Arraudeau")), in view of Jeffcoat (U.S. Patent No. 5,871,756 ("Jeffcoat")), Mizuno (U.S. Pat. No. 4,350,679 ("Mizuno")) and Leis, Jr. (U.S. Pat. 5,149,541 ("Leis")).

The Office relies on Arraudeau for teaching a wax-based mascara composition comprising 10% by weight of carnauba wax and keratin hydrolysate and gum, which are alleged to be water-soluble polymers. In particular, the Examiner relies on Example 4 of Arraudeau wherein carnauba wax and beeswax are used in the ratio of 3.3:1. Office Action at p. 2. The Office acknowledges that Arraudeau fails to teach that the composition is a wax-in-water emulsion and the particle size of the wax. *Id.* at pp. 2-3.

The Office relies on Jeffcoat for teaching that triethanolamine stearate is a well-known oil-in-water emulsion. *Id.* at p. 3. Mizuno is relied upon for teaching that carnauba wax powder having a particle size of less than 80 mesh is conventionally used in cosmetic and pharmaceutical arts. *Id.* Although the Examiner has not provided sufficiently clear statements of reliance, Applicants have presumed that the Office relies on Leis for teaching that 80 mesh is equivalent to 177 microns. *Id.*

In view of these combined teachings, the Office argues that it would have been obvious to have made Arraudeau's composition by using the carnauba wax powder having a particle size greater than 1 micron since one would allegedly be motivated by Mizuno and Leis "because of the expectation to successfully produce the composition with ingredients that are conventionally used and available in [the] cosmetic art." *Id.* Applicants respectfully disagree with the Office.

To establish a case of obviousness, the Office must show that there is a motivation to combine the references cited against the application, that there is a reasonable expectation of success, and that the prior art teaches all of the claimed limitations. See M.P.E.P. § 2143. Applicants submit that the cited references, taken alone or in combination, fail to teach or suggest all the claim elements of the rejected claims. Further, the Office relies on non-analogous art, which cannot be properly used as a basis for the pending rejection.

The Office has acknowledged that Arraudeau fails to teach the particle size of the wax. Office Action at p. 3. Yet, the Office has failed to provide any teaching in the art of this claimed invention. In fact, none of the cited secondary references teach the claimed particle size. In particular, Jeffcoat does not overcome the admitted

deficiencies of Arraudeau, *i.e.*, that Arraudeau fails to teach a wax-in-water emulsion and the specific particle size of the wax employed as required by pending claim 1 *i.e.*, greater than or equal to at least 1 μm in size. Additionally, both Mizuno and Leis fail to disclose a wax-in-water emulsion.

Moreover, Applicants believe the rejection is improper because the secondary references (Mizuno and Leis) are non-analogous art. In order for the Office to rely on a reference as a basis for rejection, the "reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." M.P.E.P. § 2141.01(a) citing *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992). A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem. *Id.*

Applicants respectfully submit that Mizuno and Leis are non-analogous and should not have been applied as art against the pending application. In particular, Mizuno is directed to the use of carnuba wax to maintain the coating of soft capsule which contains liquid pharmaceuticals, such as Vitamin E capsules. Mizuno, col. 1, lines 14-66. This reference is clearly not in the field of the Applicants' endeavor, *i.e.*, a mascara composition, and is not pertinent to the particular problem with which the inventors were concerned, *i.e.*, curling and/or thickening keratin fibers. Moreover, the use of carnuba wax as a coating for soft capsules would not have logically commended itself to the present inventors' attention when considering how to curl and/or thicken keratin fibers by applying a mascara composition. While Mizuno uses carnuba wax that

has been screened on an 80 mesh sieve in order to make the particles of a uniform size, the Office has failed to explain how the particle size of the wax for coating a capsule is relevant to the particle size of wax in an emulsion in a mascara composition.

The Office appears to rely on Leis' teaching that 80 mesh is equal to 177 microns. However, Leis, which discloses psyllium husk comprising various particle sizes, is non-analogous art since it is clearly not in the field of the Applicants' endeavor, *i.e.*, a mascara composition, and is not pertinent to the particular problem with which the inventors were concerned, *i.e.*, curling and/or thickening keratin fibers. Specifically, Leis discloses the use of psyllium husk in products "suitable for oral administration, especially products to be mixed in liquids to form psyllium-containing drinks," *id.* at col. 1, lines 9-13, and is directed to improving the palatability of psyllium-containing drinks. *Id.* at col. 1, lines 48-51; col. 2, lines 1-8. The problem Leis attempts to address would not be pertinent to the particular problem of curling or thickening keratin fibers.

Moreover, the particle size of psyllium husk would not have logically commended itself to the present inventors' attention when considering how to curl and/or thicken keratin fibers by applying a mascara composition. While Leis uses psyllium husk that has been screened on an 80 mesh sieve, the Office has failed to explain how the particle size of psyllium is relevant to the particle size of wax in an emulsion in a mascara composition.

In summary, Arraudeau in combination with Jeffcoat fail to teach each and every limitation of the claimed invention and specifically, the particle size claimed by claim 1. Mizuno and Leis cannot be properly applied against the claimed invention because they represent non-analogous art. For at least these reasons, the Examiner has failed to

establish a prima facie case of obviousness. As such, Applicants respectfully ask that it be withdrawn.

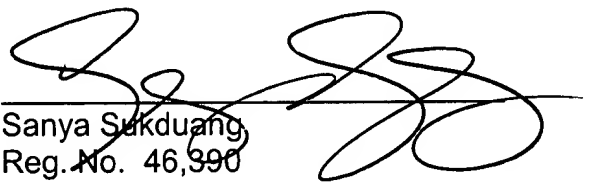
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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